

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KARL BRUCE THOR

Serial No.: 10/049,427

Patent No. 7,718,705

Filed: MAY 6, 2002

Issued: MAY 18, 2010

Atty. File No.: 4220-78-PUS

For: METHODS OF USING RAPID-ONSET
SELECTIVE SEROTONIN REUPTAKE
INHIBITORS FOR TREATING
SEXUAL DYSFUNCTION

Group Art Unit: 1617

Examiner: YONG SOO
CHONG

Conf. No.: 1087

REQUEST FOR
RECONSIDERATION UNDER
37 C.F.R. § 1.705(d)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

1. This statement is respectfully submitted in support of the "Application for Patent Term Adjustment Including Request for Reconsideration Under 37 C.F.R. § 1.705(d)" for the above-referenced patent. In view of the following, it is respectfully requested that Applicant be granted a patent term adjustment of **1,336** days.

2. The patent term adjustment indicated on the Decision on Application for Patent Term Adjustment (hereinafter "Decision") mailed April 12, 2010 is 724 days. An Application for Patent Term Adjustment was filed on July 16, 2009, requesting recalculation of patent term adjustment indicated as reported with the Notice of Allowance. The Application was granted on some bases; however, the Decision indicated the request as it related to the Office's failure to issue the patent within three years under 37 C.F.R. § 1.705(b) was dismissed as premature. The Patent Term Adjustment as granted in the Decision is summarized below:

PTO Delay

14-month delay under 1.702(a) and 1.703(a)(1)	40 days
4 month delay under 1.702(a) and 1.703(a)(2)	159 days
Appeal delay under 1.702(a) and 1.703(a)(4)	765 days
Total PTO Delay	964 days

Applicant Delay

Resp to 1st Office Action under 1.704(b)	91 days
Resp to 2nd Office Action under 1.704(b)	28 days
Resp to 3rd Office Action under 1.704(b)	90 days
IDS under 1.704(c)(8)	31 days
IDS under 1.704(c)(8)	271 days
Total Applicant Delay	511 days
PTO Delay Adjustment	271 days
Resulting PTA Granted in Decision	724 days

Copies of the Application, Petition and Decision are submitted herewith. Patentee notes that this information was recorded in PALM and in Patent Term Adjustment History ("PTA History") tab provided by the Office and available in PAIR; however, this information has currently been removed.

3. The patent term adjustment under 35 U.S.C. § 154(b) indicated on the patent is 869 days (a copy of the relevant page of the Patent is submitted herewith). This determination of 869 days is in error. The correct patent term adjustment is **1,336 days**. The relevant grounds for adjustment under 37 C.F.R. § 1.702 include: (a) "Failure to take certain actions within specified time frames", and (b) "Failure to issue a patent within three years from the actual filing date of the application". Additional relevant dates and facts will be discussed below.

A. Grounds for Adjustment of Patent Term due to Examination Delay under 1.703(a)(6)
37 C.F.R. § 1.703(a)(6) provides that the period of adjustment under § 1.702(a) includes the number of days in the period beginning on the day after the date that is four months

after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued. The issue fee was paid on July 16, 2009 and the Patent was issued on May 18, 2010. Consequently, the period of adjustment is 183 days. This number is in agreement with the PTA History tab provided by the Office and available on PAIR.

B. Reduction of Period of Adjustment of Patent Term Pursuant to 37 C.F.R. § 1.704

An amendment under 37 C.F.R. § 1.312 was filed concurrently with the Notice of Allowance. Under 37 C.F.R. § 1.704(c)(10)(i) the adjustment will be the lesser of:

“(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office Action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months...”

A response to the Amendment under Rule 312 was mailed on September 29, 2009. The numbers of days from the date of the amendment under § 1.312 and the mailing date of the response is 76 days. Since 76 days less than four months, the delay is 76 days. This number is in agreement with the PTA History tab provided by the Office and available on PAIR.

C. “Three Years Delay” Pursuant to 37 C.F.R. § 1.703(b)

Applicants are entitled to a period of patent term adjustment pursuant to 37 C.F.R. § 1.703(b). The period of delay under 37 C.F.R. § 1.703(b) is equal to the number of days in the period beginning on the day after the date that is three years after the filing date, which is the date that the national stage commenced under 35 U.S.C. § 371(b), and ending on the date a patent is issued, but not including the number of days, if any, in the period beginning on the date on which a request for continued examination (RCE) under 35 U.S.C. § 132(b) was filed and ending on the date the patent was issued (hereinafter “Three Years Delay”). The national stage commenced on March 3, 2002; three years after that date is March 3, 2005. Patentee notes that the PTA history tab lists May 6, 2002 as the filing or 371(c) date, but that the “actual filing date” for purposes of calculating Three Years Delay is the date at which the national stage is commenced under

section 371(b), or March 3, 2002. An RCE was filed on July 28, 2006; therefore, the period of Three Years Delay will be the number of days between March 3, 2005 and July 28, 2006, or **512** days. This value was not listed in the calculations by the Office.

As set forth in 37 C.F.R. § 1.703(f), Applicant is entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 C.F.R. § 1.702 (hereinafter “Office Delay”) reduced by the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 C.F.R. § 1.704 (hereinafter “Applicant Delay”). In this petition, the sum of the period of the 14 Month Delay and the period of the 4 Month Delay under 37 C.F.R. § 1.703(a) is referred to as “Examination Delay.” In this petition, the period caused by successful appellate review pursuant to 37 C.F.R. § 1.703(e) is referred to as “Appeal Delay”. With respect to the above-referenced application, the total period of Office Delay is the sum of the period of the Three Years Delay (**512** days) under 37 C.F.R. § 1.703(b), the period of Examination Delay (**199** days) under 37 C.F.R. § 1.703(a), as calculated in the Decision and the “Appeal Delay” (**765** days) under 37 C.F.R. § 1.703(e), as calculated in the Decision *to the extent these periods of delay are not overlapping*. As the period of 14 Month Delay ended on July 6, 2003, prior to the first day of the period of Three Years Delay, i.e., March 4, 2005, Applicant submits that these periods are not overlapping. Patentees notes, however, that the 159 day period of 4 Month Delay (November 21, 2004 to March 10, 2005) overlaps with the Three Year Delay period (March 3, 2005 to July 28, 2006), resulting in **7** days of overlap (March 3, 2005 to March 10, 2005). The period of the Three Year Delay and the Appeal Delay do not overlap, as the Three Year Delay ends with the filing of the RCE on July 28, 2006 and the Notice of Appeal was filed January 3, 2007. Accordingly, Patentee submits that the additional PTA calculations to be considered after Decision of on Application for Patent Term Adjustment as of Issue Date of Patent are as follows:

Three year delay	512 days
Examination delay 1.702(a) and 1.703(a)(6)	183 days
Applicant delay	(76 days)
<u>Overlap</u>	<u>(7 days)</u>
Total	612 days

The Total PTA is therefore the sum of 724 days as calculated in the Decision, plus 612 days as calculated above, for a total of 1,336 days.

D. No Terminal Disclaimer

In accordance with 37 C.F.R. § 1.705(b)(2)(iii), Applicant states that the above identified application is not subject to a terminal disclaimer.

E. Conclusion

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of **1,336 days**.

Respectfully submitted,

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